#13
11/7/01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 65691/163

In re patent application of

Inventor: Patrice DEBREGEAS *et al.*

Serial No.: 09/312,485 Group Art Unit: 1619

Filed: May 17, 1999 Examiner: S. Sharareh

For: GRANULES CONTAINING A PLANT SUBSTANCE AND PROCESS FOR PREPARING THEM

PETITION TO WITHDRAW FINALITY OF OFFICE ACTION UNDER 37 C.F.R. § 1.181

Commissioner of Patents
Washington, D.C. 20231
Box: **PETITION**

Sir:

Timing and Nature of the Petition

This is a petition to withdraw the finality of the Office Action mailed May 31, 2001 ("Office Action"), in the above-identified application. On August 28, 2001, Petitioners filed a response to this Office Action under 37 C.F.R. § 1.116, requesting that the finality of the Office Action be withdrawn. That response properly constitutes Petitioners' request for reconsideration within the meaning of Rule 181(c). The Examiner issued an Advisory Action on September 21, 2001 ("Advisory Action"). Petitioners understand that the Advisory Action was issued in lieu of a new Office Action, indicating that the Examiner has refused Petitioners' request for reconsideration. Petitioners further believe that the refusal to withdraw finality of the action starts the two month time frame for filing a petition, within the meaning of Rule 181(f). Accordingly, this petition is timely filed by November 21, 2001, two months from the mailing date of the Advisory Action.

Although Petitioners believe the amount of the fee is correct, the Commissioner is hereby authorized to credit any overpayment or to charge any deficiency to Deposit Account No. 19-0741.

Argument

Generally, an Office Action is not made final when new rejections are raised. See MPEP § 706.07(a). The present Office Action was not made final allegedly because "amendments to the independent and dependent claims have modified the scope of the pending claims, necessitating the new grounds of rejection." Office Action at page 4.

This "new grounds of rejection" was a rejection of claims 1, 2, 4, 5 and 16-20 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent 5,427,800 ("Cingotti"), which Petitioner made available in the IDS filed February 3, 1999. Since the new rejection was over Cingotti, the Examiner must allege that that the amendments to claims 1, 2, 4, 5 and 16-20 modified the scope of the invention, such that these claims are now anticipated by Cingotti, whereas they were not anticipated by Cingotti before amendment.

The amendment to claims 1, 2, 4, 5 and 16-20 are shown by a marked-up copy of these claims, attached as **Exhibit I**. These amendments were made to replace phrases common in international practice with phrases that comport more closely with standard practice in the United States. Namely, in all the claims, "characterized in that each comprise" was replaced with "comprising." In claims 2, 4, 5, and 16-20, "characterized in that" was replaced with "wherein." In claim 2, language appropriate to identify a Markush group was inserted. In claim 5, "intended to mask the taste and/or the odour" was replaced with "capable of masking the taste or odor." In claims 16-20, "Process according to Claim" was replaced with "The method according to claim." Finally, "Neutres" was replaced with "neutral core."

The amendments have replaced some expressions with equivalent expressions that are more preferred in the United States. Such modifications to the claims do not affect the scope of the subject matter protected by the claims. Indeed, in his rejection of these claims over Cingotti, the Examiner has not pointed to any line of reasoning to explain why these cosmetic or formalistic changes modify the scope of the protected subject matter, such that the claimed invention is now allegedly anticipated.

It follows that the new rejection cannot be predicated on changes to the scope of protected subject engendered by amendment. Accordingly, the rationale for making the Office Action final is erroneous. Petitioners respectfully urge that the finality of this Office Action accordingly be withdrawn.

As stated in the MPEP, "[t]he applicant who is seeking to define his or her invention . . . [should] not be prematurely cut off in the prosecution of his or her application." MPEP §706.07. Since the rejection over Cingotti has been maintained in the Advisory Action, removal of finality of the Office Action thus will afford Petitioners their proper opportunity to respond in full to the rejection and will prevent them from being prematurely cut off from prosecution. To this end, the Examiner's remarks in the Advisory Action properly should be submitted in a new Office Action.

Conclusion

In view of the foregoing, acceptance of the petition is respectfully urged, so that the finality of the Office Action may be withdrawn. Petitioners accordingly request that the Examiner's remarks in the Advisory Action be made of record in a new Office Action.

Respectfully submitted,

Oct. 4, 2001
Date

Brian K. Lathrop
Reg. No. 43,740

FOLEY & LARDNER
Suite 500, 3000 K Street, N.W.
Washington, D.C. 20007-5109
Telephone) (202) 672-5300
Facsimile: (202) 672-5399

EXHIBIT I

Marked-up copy of the pending claims as amended

1. (Amended) Granules containing at least one plant substance, [characterized in that that each comprise] comprising a neutral core having a particle size of between 200 and 1600 μm coated with a layer containing the plant substance combined with a pharmaceutically acceptable excipient.

2. (Amended) Granules according to [Claim] claim 1, [characterized in that] wherein the neutral core consists of a substance [chosen from] selected from the group consisting of sugar, starch, mannitol, sorbitol, xylitol, cellulose, talc, and mixtures thereof.

4. (Twice amended) Granules according to [Claim] claim 1, [characterized in that] wherein the layer containing the plant substance contains a binder [such as sucrose, polyvinylpyrrolidone, lac gum or hydroxypropylmethylcellulose].

5. (Twice amended) Granules according to [Claim] claim 1, [characterized in that] wherein the layer containing the plant substance is coated with an outer layer [intended to mask the taste and/or the odour] capable of masking the taste or odor of the plant substance[, to delay its release or to control its release].

16. (Twice amended) [Process according to Claim] The method according to claim 11, [characterized in that] wherein the size of the [Neutres] neutral core is between 950 and 1400 μm, [when] and wherein the plant extract is dry.

17. (Twice amended) [Process according to Claim] The method according to claim 11, [characterized in that] wherein the size of the [Neutres] neutral core is between 900 and 1250 μm, [when] and wherein the plant extract is soft or fluid.

18. (Twice amended) [Process according to Claim] The method according to claim 11, [characterized in that] wherein the percentage by mass of fluid extract used is between 15 and 25% relative to the weight of the granules.

19. (Twice amended) [Process according to Claim] The method according to claim 11, [characterized in that] wherein the percentage by mass of dry extract [used may be] is as high as 75% relative to the weight of the granules.

20. (Twice amended) [Process according to Claim] The method according to claim 11, [characterized in that] wherein the granules are prepared in a pan or in a fluidized air bed.